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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/710,950

11/13/2000

Nobuhito Matsumoto

ACH2705P1US

6329

7590

10/06/2003

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EXAMINER

NGUYEN, CAM N

ART UNIT

PAPER NUMBER

1754

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/710,950**

Applicant(s)  
**Matsumoto et al.**

Examiner  
**Cam Nguyen**

Art Unit  
**1754**



-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 13, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) 7 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☐ Claim(s) is/are rejected.
- 7) ☒ Claim(s) 1 and 3-6 is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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### **DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a process for preparing spherical oxide particles and a process for preparing a hydroprocessing catalyst, classified in class 502, subclass 300+.
  - II. Claim 7, drawn to a process for hydroprocessing of a hydrocarbon feed, classified in class 208, subclass 107.

The inventions are distinct, each from the other because:

2. Inventions I and II are unrelated (distinct). Inventions are unrelated (distinct) if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are: the Group I invention and Group II invention are drawn to two different processes, which produce different products. The product obtained by the process of Group I is a spherical oxide particles and a hydroprocessing catalyst; whereas, the product obtained by the process of Group II is a hydrocarbon related etc.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and have acquired a separate status in the art as shown by their different classification, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. In accordance with M.P.E.P. 812.01, a telephone call was made by *Examiner Nadine Norton (Art Unit 1764)* to applicant(s) Attorney/Agent *Mr. Louis Morris* on *August 5, 2002* a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claim 7 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

#### ***Claim Objections***

7. Claims 1 & 3-6 are objected to because of the following informalities:
  - A. In claim 1, line 1, -- : -- needs to be inserted after "steps of".
  - B. In claim 1, line 5, ",", should be changed to -- ; --.
  - C. In claim 1, line 6, ",", should be changed to -- ; --.

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- D. In claim 1, line 7, “,” should be changed to -- ; --.
- E. In claim 3, line 2, -- , -- should be inserted after “0.1 wt.%”.
- F. In claim 4, line 1, -- , -- should be inserted before “wherein”.
- G. In claim 5, line 1-3, “in which a Group VI and/or a Group VIII metal component are incorporated into spherical oxide particles prepared by way of a process comprising” should be changed to recite --comprising incorporating a Group VI and/or a Group VIII metal component into spherical oxide particles, which prepared by a process comprising--.
- H. In claim 5, line 3, -- : -- needs to be inserted after “steps of”.
- I. In claim 5, line 7, “,” should be changed to -- ; --.
- J. In claim 5, line 8, “,” should be changed to -- ; --.
- K. In claim 5, line 9, “,” should be changed to -- ; --.
- L. In claim 6, line 1-2, “wherein the metal components are a Group VI metal component and optionally a Group VIII metal component” should be rewritten to recite --comprising a Group VI metal component and, optionally, a Group VIII metal component--.

Appropriate correction is required.

***Allowable Subject Matter***

- 8. Claims 1-6 are not being rejected under the art rejection because they contain allowable subject matter. The following is a statement of reason(s) for allowance of the claimed subject matter.

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As concern with claims 1-2, the prior art does not disclose or fairly suggest a process of preparing spherical oxide particles requiring the combination of the steps as set forth in claim 1.

As concern with claims 3-4, the prior art does not disclose or fairly suggest spherical oxide particles having a wear rate as recited in claim 3.

As concern with claims 5-6, the prior art does not disclose or fairly suggest a process of preparing a hydroprocessing catalyst using spherical oxide particles prepared by a process requires the combination of the steps as set forth in claim 5.

There is no motivation to combine the teachings of the references together.

### ***Citations***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cottringer et al. (US Pat. 5,395,407) & Hensley, Jr. et al. (US Pat. 4,399,057) are cited for related art.

### ***Conclusion***

10. Claims 1-7 are pending. Claims 1 & 3-6 are objected. Claim 2 is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (703) 305-3923. The

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examiner can normally be reached on M-F from 8:30 am. to 6:00 pm, with alternative Monday off.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (before finals) and (703) 872-9311 (after-final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nguyen/cnn



September 27, 2003



Cam Nguyen

Patent Examiner

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